

REMARKS

The Office Action has restricted the claims into twenty groups.

Group I, claim(s) 67-97, drawn to a double stranded compound comprising at least one LNA monomer having the first structure (on the left) of claim 67.

Group II, claim(s) 67-97, drawn to a double stranded compound comprising at least one LNA monomer having the second structure (on the right) of claim 67.

Groups III-XX, collectively claims 98-101, are drawn to methods of treating diseases using the compounds of Groups I and II.

Applicant elects Group I with traverse and respectfully requests that the Examiner consider the claims of Group I and Group II together.

The Office Action states that the inventions listed as Groups I-XX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features. The Office Action cites Thru et al., U.S. 2004/0096848 (the '848 publication) for allegedly teaching a double stranded compound comprising a LNA monomer as set forth in claim 67 (e.g., see claims 1-8 of Thru et al.).

The restriction separates the two LNA structures of claim 67 (Group I and II). The structures in claim 67 refers to the two alternative stereochemistries of LNA nucleotides, beta-D or alpha-L, the separation of LNA into two groups is not appropriate as beta-D and alpha-L do combine to form the same special technical feature, specifically LNA. Therefore both provide the same contribution to a single inventive concept in present invention

Applicant submits that Thru et al. is not available as art against the instant application. The instant application claims priority to US Provisional Patent Application Serial No. 60/456,888 filed on March 21, 2003. The '848 publication is based on an application filed on October 23, 2003, after the filing date of the instant application.

Although the face page of the '848 publication states that the application is related to US Provisional Patent Application 60/370,126, the provisional application was filed on April 5, 2002, more than a year before the filing of the application that became the '848 publication. Therefore, the application that became the '848 publication cannot claim priority to the provisional patent application, and cannot be available as prior art against the instant claims. Applicant notes that inclusion of a reference in an Information Disclosure Statement is not an admission that the reference is prior art. Instead, Applicant is required to provide documents believed to be material to the examination of the claims which can include references available only after the filing date of the application.

Applicant submits that the claims of Groups I and II provide a single inventive concept and should be examined together. Applicant has cancelled the remaining claims of groups III-XX for being drawn to non-elected inventions. Applicant reserves the right to pursue the claims in one or more divisional applications.

In further support of the claims of Groups I and II forming a single inventive concept, Applicant provides herewith the allowed claims from the corresponding European Patent for which an Issue Certificate was mailed on September 23, 2009. Applicant notes that the requirements for unity of invention in a PCT National Phase application are the same in the USPTO and the EPO.

FEE AUTHORIZATION

The Director is authorized to charge the fee for a one month extension of time for reply to Deposit Account No. 04-1105, under Order No. 64190(45120). The Director is further authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm in relation to this application) to our Deposit Account No. 04-1105, under Order No. 64190(45120).

An Office Action on the merits is respectfully requested.

Dated: October 22, 2009

Respectfully submitted,

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